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10/034,414	12/27/2001	Christopher Pasqualino	13315US02	1160
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EXAMINER				
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/034,414
Filing Date: December 27, 2001
Appellant(s): PASQUALINO, CHRISTOPHER

Mirut P. Dalal
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 20, 2010 appealing from the Office action mailed January 20, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-18 were cancelled.

Claims 19-21 were rejected under 35 U.S.C. § 103(a) as being obvious from Mair.

The rejection to claims 19-21 are appealed.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

Mair et al. "US Patent Application Publication no. 2002/0186322 A1" December 12, 2002;
Mair et al. Provisional Application No. 60/296,924, filed on June 8, 2001.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mair et al. (US Patent Application Publication no. 2002/0186322 A1).

As per claims 19-21, Mair discloses a system for transmitting auxiliary data in video encoding comprising an encoder and a decoder adapted to communicate with encoders (See Abstract, and paragraph [0042], lines 4-6; and [0043]).

It is noted that while Mair provides the encoding and decoding in figs. 3A, 3B and 5, it is silent about the enhanced and un-enhanced aspect of the coding/decoding process. However, from paragraphs [0041 to paragraph 0044] Mair discloses several encoding and decoding techniques wherein the encoding is performed with modulation, and the receiver/decoder receives the data without being encoded in [0044], and the receiver/decoder may send recovered auxiliary data to generate data path based on the accuracy of the auxiliary data. These steps are considered either equivalent or render

the enhanced and un-enhanced encoding/decoding obvious to one skilled in the art since the purpose of using enhanced/or unenhanced decoder/encoder is to transmit the auxiliary data without prior knowledge of the capability of the video receiver receiving auxiliary data as suggested by Mair in [0044].

(10) Response to Argument

The appellant noted that: *To reject claim 19, Examiner indicated that "As per claims 19-21, most of the limitations of these claims have been noted in the above rejection of claims 1, 12, and 13", FOA at 5, and that "Mair discloses the same method of transmitting auxiliary data in video encoding (See Abstract) comprising receiving first and second data (See [0042], lines 4-6), encoding the first data based on a state of at least one bit of the second data (See [0033], lines 7-19 and [0035, lines 7-16), packaging the encoded first data and the second data into a single word (See [0042]), and communicating the single word (See [0043])." FOA at 4.*

While the Examiner understands the appellant's note, claims 19-21 were rejected in the last office action without referring back to cancelled claims 1, 12 and 13. The Examiner considered only the limitations of claims 19-21.

The appellant noted that US Patent Application no. 2002/0186322 to Mair et al. was filed on October 15 2001 and claimed priority to provisional application no. 60/296,924, filed June 8, 2001.

The appellant then argued that serial no. 60/296,924 does not properly support the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112 first paragraph.

The examiner respectfully disagrees. The provisional application, while it may appear to the applicant as a paper or proposal, it does contain elements and language that would support the Patent Application Publication no. 2002/0186322 to Mair et al. The proposal submitted on the provisional application contains the elements to meet the 35 U.S.C. 112 first criteria.

The Appellant further noted that: *that the present application claims a priority date to August 17, 2001 under 35 U.S.C. § 119(e)(1) . The Appellant notes that Mair was filed on October 15, 2001 and claims priority to provisional application, Serial No. 60/296,924, filed June 8, 2001 (hereinafter, "the '924 Application").*

The Appellant further added that: *Although 35 U.S.C. 103(a) does not set forth what can be used as "prior art", "[p]rior art available under 35 U.S.C. 102 is available under 35 U.S.C. 103." MPEP 2141. While the rejection is made under 35 U.S.C. 103(a), it appears as though Examiner is claiming that Mair is prior art under 35 U.S.C. 102(e).*

Reference is made to the following citation from the MPEP:

The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions **if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.**

The Examiner respectfully disagrees with the appellant. The provisional application clearly notes in the introduction that the DVI signal perform the encoding while two additional bits perform specific and distinct functions (See Introduction of the Mair's Provisional Application lines 1-2).

Mair's US provisional application is no. 60/296,924 with the title : **"Proposal for Audio Transport While Retaining Backwards Compatibility"** .

The Examiner relied upon the whole document, and particularly the introduction of the provisional application which clearly introduces DVI for performing 8B/10B encoding.

The appellant further argued that the '924 Application does not properly "support the subject matter relied upon to make the rejection in compliance with 35 USC 112 first paragraph." The appellant never presented any argument with respect to the merits of the claim. The appellant does not believe that provisional application provides enough details in order to rely upon the filing date.

To the examiner, the proposal does provide a DVI encoding an 8B/10B encoding where auxiliary data perform specific function and distinct function. The additional data as seen in the introduction is the auxiliary data.

Claim 19 of the application calls for a system for transmitting auxiliary data in video encoding comprising: an un-enhanced encoder; an enhanced encoder;
an un-enhanced decoder adapted to communicate with said un-enhanced and enhanced encoders;

and an enhanced decoder adapted to communicate with said un-enhanced and enhanced encoders.

In rejecting the claim, the Examiner used the disclosure of US Patent Application Publication to Mair to show where the limitations are met. The Appellant's arguments are not directed to the Publication, but the '924 provisional application. The examiner understood that there is a difference between provisional '924 application and the actual application publication. To the examiner, the provisional application provides enough disclosure in order to use the date for priority purpose for the Patent Application Publication of Mair.

The appellant further argued that the provisional application '924 merely summarizes the use of the 8bit/10bit encoding process but does not make reference Figs. 1-5. The Examiner respectfully disagrees. While provisional application '924 does not provides any drawings, each section of the proposal provides a summary of the actual Patent Application used to meet the limitations.

The reason of using enhanced and unenhanced encoding/decoding as claimed in claim 19 is to transmit auxiliary data without prior knowledge of the capability of the receiver receiving auxiliary data as suggested by Mair in [0044]. The additional bits as disclosed in the Introduction (i.e., bit 8 and bit 9) are the auxiliary data sent for performing specific and distinct function. The purpose of bit 8 and bit 9 is given in the application '924.

The examiner reminds the appellant that bits 8 and 9 will be used to transport audio information. The elements of the Patent Application Publication of Mair et al. (i.e., Publication no. 2002/0186322 A1) are proposed in the provisional application.

In addition, the Principle of operation as well as in the section named "proposal" were considered by the examiner. Considering the fact that the elements of the abstract of Mair's Publication (2002/0186322 A1) are found in the proposal (which is the provisional application), it is clear to the examiner that one skilled in the art can and would look to the provisional application to derive the Abstract as well as to find the claimed limitations of the applicant.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/G. S. P./
/Gims S Philippe/
Primary Examiner, Art Unit 2482

December 2, 2010

Art Unit: 2482

Conferees:

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